

REMARKS

The Office Action of October 16, 2003 has been reviewed and carefully considered.

In this response to the Office Action, independent claim 4 has been amended, dependent claims 5 to 9 remain unchanged, and claims 4 through 9 (as herein amended) now remain pending.

Reconsideration of the above-identified application, as herein amended, is respectfully requested.

In the "final" Office Action of October 16, 2003, the Examiner has once again rejected independent claim 4 under 35 U.S.C. §102(b) as allegedly anticipated by Bagwell et al. (U.S. Patent No. 5,101,997).

The disclosure and teachings of Bagwell have been extensively discussed during the prosecution of this application, most recently in applicant's Amendment dated September 24, 2003. Rather than repeating that discussion, applicant's remarks from that prior Amendment of September 24, 2003 are expressly incorporated herein by reference.

Applicant once again reiterates that the key novel feature of its waste bin assembly invention lies in its construction and configuration for mounted securement *only* to the underside of an elevated work surface so as to freely suspend its plural waste-receiving compartments from the elevated work surface without any additional direct or indirect support of the waste bin assembly from an underlying floor surface above which the work surface is elevated, as applicant's independent claim 4 expressly recites. The waste bin assembly of Bagwell, in contrast, is especially constructed, configured and, as Bagwell clearly discloses and teaches, intended for being supported directly on and from an underlying ground or floor surface by the caster-carrying tray 28 on which the unit's base 24 sits, and relative to which the tray (and the attached support structure and bins) is

rotatable about the central axis that is defined by the bearing race 26. Bagwell, accordingly, quite clearly does *not* meet the express recitations of applicant's independent claim 4.

Moreover, despite the Examiner's statement in the Office Action that the Bagwell waste bin assembly "is capable of being mounted to an underside of an elevated work surface", the Bagwell patent neither discloses nor supports nor suggests such suspended securability and, indeed, by virtue of the disclosed construction of the Bagwell assembly any modification thereof to render it "capable of being secured" in hanging or suspended relation to the underside of an elevated work surface "for suspending the compartments from the work surface" would require extensive, wholesale changes to its structure that could only result from a directed intention to simulate applicant's invention based on impermissible hindsight reconstruction. *Nothing* in Bagwell either teaches or suggests any such modification to render the Bagwell assembly securable to the underside of an elevated work surface so as to entirely suspend the assembly from the underside of the elevated work surface, and neither is there any motivation either in Bagwell or in any of the other art of record to suggest such a fundamental redesign and reengineering of the assembly that Bagwell actually teaches in his patent.

Applicant has further amended independent claim 4 to still more clearly and unarguably express that its waste bin assembly is suspended "entirely from the underside of the elevated work surface without additional support either directly or indirectly from an underlying floor surface above which the work surface is elevated". The Bagwell patent fails to disclose the structure or functionality of the waste bin assembly as recited in applicant's claim 4, fails to suggest any modification of the Bagwell assembly to meet the express and inherent limitations set forth in applicant's independent claim 4, and provides *zero* motivation for the extensive and fundamental

changes that would have to be made to the Bagwell assembly to result in either the structure or advantageous functionality that is expressly recited in applicant's independent claim 4.

The "final" Office Action of October 16, 2003 additionally rejects independent claim 4 under 35 U.S.C. §102(b) as also allegedly anticipated by the Moon Patent (No. 1,207,598). Here, too, the receptacle support and cover disclosed by Moon fails to meet the express recitations of structure and functionality that are recited in applicant's claim 4.

Thus, in Moon the vertically-extending shaft 6, from which a shelf 10 for supporting a receptacle R is mounted for receptacle-displacing rotation of the shelf 10 about the shaft axis, is *not* secured or mounted, or securable or mountable, to the underside of an elevated work surface without additional support either directly or indirectly from an underlying floor surface above which the work is elevated. Instead, the shaft is mounted to brackets which are themselves secured to a *vertical* or "upright support [S] in the form of a wall to the upper end of which one end of a common type of counter C is secured". Thus, the Moon assembly is mounted, at both ends of the vertical shaft, to an *upright wall* -- it is obviously *not* "suspended entirely from the underside of an elevated work surface without additional support either directly or indirectly from an underlying floor surface above which the work surface is elevated", as applicant's claim 4 expressly recites. Neither does Moon disclose or suggest inclusion of a *plurality* of waste-receiving compartments, as is also expressly recited in applicant's independent claim 4. The Moon patent quite clear does *not* anticipate independent claim 4.

Neither, moreover, is there any suggestion or apparent motivation, absent applicant's disclosure, for modifying the construction disclosed by Moon to suspend the Moon assembly "entirely from the underside of the elevated work surface without additional support either directly or indirectly from an underlying floor surface above which the work surface is elevated", as

applicant recites in independent claim 4. Indeed, modification of the Moon assembly to provide this expressly recited aspect of applicant's invention would require, first, that the upper bracket 1 that is shown secured to the upright vertical wall be modified to secure the shaft top end directly to the underlying surface of the counter C and, second, that the lower bracket 2 (which is also shown secured to the upright vertical wall) be eliminated and, third, that some additional structural modification be made to the assembly to prevent the shaft 6, which as disclosed by Moon rests supportedly on the lower arm 3 of the lower bracket 2, from simply falling (under the force of gravity) from its engagement with upper bracket 1 whereby the entire assembly would simply crash to the floor and fall over on its side. Such an extensive redesign and modification of the disclosed assembly of Moon -- indeed, any modification of the Moon assembly -- is neither taught nor suggested by Moon, and neither is there any apparent motivation in any of the art of record to perform such an extensive reconstruction of the Moon device for any purpose, let alone to simulate the structure and functionality of applicant's claimed invention.

Indeed, none of the prior art disclosures that have been cited by the Examiner provides the most basic functionality that lies at the heart of applicant's claimed invention -- i.e. a waste bin assembly that is mountable *only* to the underside of an elevated work surface such that the waste bin assembly is suspended *entirely* from the underside of the elevated work surface without additional support either directly or indirectly from an underlying floor surface above which the work surface is elevated. While both the cited Ford et al. patent (No. 367,802) and the cited Powers patent (No. 1,309,776) disclose assemblies which are shown secured to the underside of an elevated work surface, in each case the assembly *is additionally secured to the floor itself*, so that neither of those patents teaches, or discloses, or suggests a waste bin assembly that is mounted or mountable *only* to the underside of an elevated work surface such that the waste bin assembly is suspended

entirely from the underside of the elevated work surface without additional support either directly or indirectly from an underlying floor surface above which the work surface is elevated. This lies at the very heart of applicant's invention, and is clearly and expressly recited in applicant's independent claim 4.

Nothing, therefore, in any of the art of record either discloses or suggests the unique combination of structural features and functionality which is presented by applicant's waste bin assembly as described in applicant's independent claim 4. Nor has applicant been able to find, or has the Examiner been able to point to, any specific passage in any of the cited prior art references that would suggest to or motivate one ordinary skill in the art at the time of applicant's invention to modify that cited art, or any combination thereof, in a manner which would successfully result in the advantageous structural features and functionality of applicant's waste bin assembly as recited in applicant's independent claim 4. Only through impermissible hindsight reconstruction based on prior knowledge of applicant's disclosure and teachings might one of ordinary skill even *consider* the extreme redesign, modification and reconstruction of the assemblies of the cited prior art that would be needed to attain applicant's claimed invention.

Applicant's invention as recited in each of applicant's claims is, accordingly, neither anticipated nor rendered obvious by any of the cited art of record, whether considered individually or in any combination thereof. For at least the foregoing reasons, it is therefore believed and respectfully submitted that claims 4 through 9 are in full and proper condition for allowance and such action, and early passage of the case to issue, are once more requested.

Any additional fees or charges required at this time in connection with this application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By

A handwritten signature in black ink, appearing to be 'Lance J. Lieberman', written over a horizontal line.

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